

REMARKS

Claims 1-28 are pending in this application. Claims 1, 3, and 8 are amended for clarification purposes and to better define the scope of the claims. The amendments find support in the specification at, for example, page 7, lines 5-16. No new matter has been added.

The Office Action rejects claims 1, 2, 12, 13, 24, 25, and 28 under 35 USC 102(e) as being anticipated by *Dusse*, US Patent Publication No. 2002/0068554 (hereinafter *Dusse*). The Office Action rejects claims 3-7, 19, and 27 under 35 USC 103(a) as being unpatentable over *Dusse* in view of *Marwell et al.*, U.S. Patent No., 6,668,055 (hereinafter *Marwell*). The Office Action rejects claims 20-23 under 35 USC 103(a) as being unpatentable over *Dusse* in view of *Marwell* and further in view of *Calder et al.*, US Patent Publication No. 2001/0034244 (hereinafter *Calder*). The Office Action rejects claims 8-11, 14-18, and 26 under 35 USC 103(a) as being unpatentable over *Dusse* in view of *Kahan et al.*, US Patent Publication No. 2002/0024536 (hereinafter *Kahan*).

As to independent claim 1, Applicants assert that *Dusse* does not teach or suggest at least:

- receiving, from a user, at the mobile communication device, a request for one of the sub-features;
- searching the mobile communication device for the requested sub-feature;
- searching one of an enhanced local services server and a private web site for the requested sub-feature, if the requested sub-feature is not resident on the mobile communication device;
- accessing the requested sub-feature from the one of the enhanced local services server and the private web site; and
- receiving the requested sub-feature at the mobile communication device via a wireless channel

as recited in amended independent claim 1. As stated in the Office Action, “*Dusse* does not specifically teach of the superset of features defines an address book.” Office Action at page 5, (commenting on claim 3). Applicants appreciate this as an understanding, on the part of the Office, that *Dusse* does not contemplate and does not disclose that a feature can be comprised of a set of sub-features. *Dusse* treats services and features separately; to him they are unrelated. By contrast, independent claim 1 contemplates a method for providing enhanced features at a mobile communication device, the device including a feature having a set of sub-features, which, as stated above, is not contemplated or disclosed by *Dusse*.

As to independent claim 12, Applicants assert that *Dusse* does not teach or suggest at least:

programming the mobile communication device to provide a first set of features defining an aspect of a first service;
programming a wireless network server to provide a second set of features, supplementing said first set, to fully define said first service

as recited in independent claim 12. Applicants respectfully suggest that the Office may be engaging in hindsight reasoning to arrive at its rejection. Applicants respectfully point out that the Office Action draws support from elements 516 and 542 of FIG. 5 and paragraphs 11, 37, and 47, for its assertion of anticipation. Nowhere, however, in *Dusse*'s FIG. 5, its supporting paragraphs, or any asserted paragraphs, does *Dusse* indicate that elements 516 or 542 comprise first and second sets of features that together define a service. Applicants note that *Dusse* is totally devoid of comment or description concerning element 516. As for element 542, *Dusse* describes it as a database for device features and services. *Dusse* at para 43. As noted above, *Dusse* does not contemplate and does not disclose that a feature can be comprised of a set of sub-features. Nor does *Dusse* contemplate or disclose that a service can be comprised of a first and second set of features. *Dusse* treats services and features separately; to him they are unrelated.

As to independent claim 24, Applicants assert that *Dusse* does not teach or suggest at least:

determining whether said communication service can be satisfied by the mobile communication device as a stand alone device

as recited in independent claim 24. Applicants respectfully suggest that the Office may be engaging in hindsight reasoning to arrive at its rejection. Applicants respectfully point out that the Office Action draws support from paragraphs 32, 33, 42, and 43 for its assertion of anticipation. Applicants respectfully state that nowhere in these paragraphs is there any indication of a determination being made as to whether any service can be satisfied by the mobile communication device as a stand alone device. If the Office intends to continue with this assertion, Applicants respectfully request that the Office present its reasoning. Applicants assert that paragraphs 32 and 33 related to an initial request by a user for "features and services desired by the user." *Dusse*, at para. 33. There is no disclosure of a determination being made as to

whether a communication service can be satisfied by the mobile communication device as a stand alone device, as recited in independent claim 24. Likewise, paragraphs 42 and 43 relate to the transmission and reception of a provisioning request, but there is no disclosure as to whether the request is as a result of a determination as to whether a communication service can be satisfied by the mobile communication device as a stand alone device, as recited in independent claim 24.

For the reasons set forth above, Applicants submit that independent claims 1, 12, and 24 define patentable subject matter. Claims 2, 13, 25, and 28 depend from independent claims 1, 12, or 24 and therefore, also define patentable subject matter. Accordingly, Applicants request that the § 102(e) rejections of claims 1, 2, 12, 13, 24, 25, and 28 be withdrawn.

The Office Action has also rejected claims 3-7, 19, and 27; 20-23; and 8-11, 14-18, 26 under 35 USC 103(a) as being unpatentable over *Dusse*; in view of *Marwell*; in view of *Marwell* and further in view of *Calder*; and in view of *Kahan*, respectively. The *Dusse* reference, either alone or in combination with *Marwell*, *Calder*, and/or *Kahan*, fails to establish a *prima facie* case of obviousness for at least the reason that the prior art references when combined do not teach or suggest all the claim limitations. All of the claims rejected under 35 USC 103(a) are ultimately dependent upon claims 1, 12, and 24. As stated above, *Dusse* fails to disclose elements found in each of these independent claims. *Marwell*, *Calder*, and *Kahan* do not remedy the deficiencies of *Dusse*.

Marwell relates to a personalized directory assistance system. The system allows a user to dial and speak with a customer service representative who can then search through the user's personal contact list in accordance with the user's request. The customer service representative can then connect the user to the desired personal contact.

Calder relates to a contact management system that can manage contact information and the contents of a wireless telephone's phone book memory. The contact management system enables the collection and maintenance of information pertaining to a plurality of contacts, including voice telephone numbers of the contacts. The contact management system also enables selection and grouping of user-identified voice telephone numbers into lists, which are independently selectable and downloadable to a wireless telephone via a communication interface. The communication interface is capable of choosing an appropriate device driver,

which is compatible with the wireless telephone.

Kahan relates to the aggregation of data items to be sent to a mobile terminal subscriber. A subscriber provisioning profile is used to select desired data items, from a plurality of data items, for display on a mobile terminal. The subscriber provisioning profile contains the mobile terminal subscriber's preferences concerning the data items, and the data items are formatted for display according to the mobile terminal subscriber's provisioning profile.

For the reasons set forth above, Applicants submit that independent claims 1, 12, and 24 define patentable subject matter. Claims 3-11, 14-19, 20-23, and 26-27 depend from independent claims 1, 12, or 24 and therefore, also define patentable subject matter. Accordingly, Applicants request that the 35 USC 103(a) rejections of claims 3-11, 14-19, 20-23, and 26-27 be withdrawn.

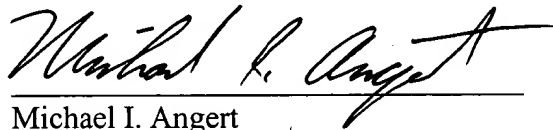
Conclusion:

The claims are allowable over the prior art for the reasons set forth above. A Notice to that effect is respectfully requested.

The Office is hereby authorized to charge all required fees, including all required claim fees under 37 C.F.R. §1.16 and/or all required extension of time fees under 37 C.F.R. §1.17, or credit any overpayments to Deposit Account 11-0600.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,



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